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10/071,490	02/07/2002	J. Alexander Marchosky	JMA 2977.1	2740
26263	7590	11/15/2007		
SONNENSCHEIN NATH & ROSENTHAL LLP			EXAMINER	
P.O. BOX 061080			FUBARA, BLESSING M	
WACKER DRIVE STATION, SEARS TOWER			ART UNIT	PAPER NUMBER
CHICAGO, IL 60606-1080			1618	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/071,490

Filing Date: February 07, 2002

Appellant(s): MARCHOSKY, J. ALEXANDER

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G. Harley Blosser  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 8/17/07 appealing from the Office action mailed

1/17/07.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 97, 98 and 103-108 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. New claims 105-108 are included in the rejection. Therefore, claims 97, 98 and 103-108 remain/are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably

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convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is new matter rejection.

The specification as originally filed does not support the scope of the presently claimed composition of claim 104. While the specification at paragraphs [0009], [0011], [0024], [0046], [0048], [0051], [0060] and [0061] supports the general composition of claim 104, the specific composition limited by the consisting essentially of now recited in claim 104 is not envisioned. The specific composition having the specific ranges as stated in the claims additionally with the consisting essentially of was not envisioned at filing. There is nothing in the specification pointing to this specific combination of components and amounts. Most of the disclosure includes growth factors. And when not present, only a few specific formulations are described but not as claimed in claim 104. See for example paragraphs [0002], [0003] and [0009].

Applicant may overcome this rejection by amending the claims to be commensurate with the composition disclosed in the specification.

#### **(10) Response to Argument**

Appellants argue that appellant had possession of the invention of claim 104, but although appellant had possession of claim 104, the specific composition of claim 104 was not envisioned by the original specification where the composition contains all four components, namely hyaluronic acid or salt thereof, cancellous bone, demineralized bone matrix and non-decalcified bone matrix, to the exclusion of growth factors. For example, all the compositions disclosed include growth factors (see for example paragraphs [0002], [0003] and [0009]). Further, the paragraphs cited by applicant all describe compositions that “comprise ...” and the

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comprising language is open and the specific composition claimed in claim 104 is not envisioned by the original disclosure.

While the examiner's communication of May 24, 2006 indicates support for a composition consisting of essentially of hyaluronic acid, cancellous bone, demineralized bone matrix, the claims have since been further examined and found that the as filed specification does not envision a composition as claimed in claim 104 to the exclusion of growth factors.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

**Please Note that pages 2 through 24 of the brief have the serial number 10/253,194 instead of 10/071,490.**

Respectfully submitted,

BF



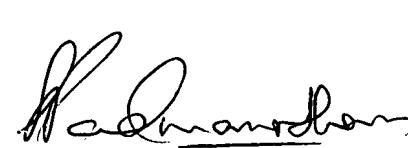
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